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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,078	11/26/2001	William Brown	P 282437 ABA-300/13004-4	2807
	7590 12/31/2003		EXAMINER	
Fitch, Even, Tabin & Flannery 1801 K Street, N.W. Suite 401L Washington, DC 20006-1201			BORIN, MICHAEL L	
			ART UNIT	PAPER NUMBER
			1631	

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

S.M.

29.71

Office Action Summary

Application No. 09/994,078	Applicant(s) BROWN ET AL.	
Examiner Michael Borin	Art Unit 1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 25 September 2003.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-58 is/are pending in the application.
4a) Of the above claim(s) 16,30-50,52,53 and 55-58 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-15,17-29,51 and 54 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11/26/01. 6) Other: _____

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DETAILED ACTION

Status of Claims

1. Response to restriction requirement filed 09/25/2007 is acknowledged. Applicant elected, without traverse, Group I, claims 1-29, 51-54. It is noted that applicant requested to cancel all claims related to non-elected invention (i.e., claims 30-50,55-58). Applicant invited to make a formal statement in response to this action that claims 30-50,55-58 are canceled, and to provide an updated version of the claims. For the purposes of this communication, claims 30-50,55-58 are considered to be withdrawn from consideration.

As per election of species requirement set forth in the previous Office action, applicants have elected, without traverse, the compound H-Tyr-D-Arg-D-Phe-Phe-NH₂. Claims reading on the elected species are 1-15,17-29, 51,54. Claims 16, 52,53 are withdrawn from consideration as drawn to non-elected species.

Claims 1-15,17-29, 51,54 are addressed to the extent they read on the elected species.

Priority

2. Applicant is not granted with priority date of previous applications 09/718585 as there are no common applicants in the instant and referenced applications.

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Accordingly, the priority of this application goes back to the immediate parent, 09/159518, with the priority date of 09/24/1998.

Claim Rejections - 35 USC § 102.

The following is a quotation of the appropriate paragraphs of 35 U.S.C.102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-15,17-29, 51,54 are rejected under 35 U.S.C. 102(e) as clearly anticipated by Wang et al (US Patent 6,337,319). Note that the reference is not considered to be a parent of the instant application for the reasons stated above.

The reference teaches opioid peptide H-Tyr-D-Arg-Phe-Phe-NH₂. See col. 6, line 23.

4. Claims 1-15,17-29, 51,54 are rejected under 35 U.S.C. 102(b) as anticipated by Saenger et al (Database Caplus, AN 127:311488)

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The reference teaches peptide H-Tyr-Arg-Phe-Phe-NH₂. The difference of the referenced compound from the instant H-Tyr-D-Arg-D-Phe-Phe-NH₂ is that Arg and one Phe residues in the claimed compound are in D-configuration. An optically active isomer is unpatentable over a prior art racemate or optical isomer of opposite rotation in the absence of unexpected or unobvious beneficial properties. In re Adamson et al., 125 USPQ 233 (CCPA 1960). Therefore, the instantly claimed compound is anticipated.

Conclusion.

5. No claims are allowed.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Borin whose telephone number is (703) 305-4506. Dr. Borin can normally be reached between the hours of 8:30 A.M. to 5:00 P.M. EST Monday to Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Michael Woodward, can be reached on (703) 308-4028. The fax telephone number for this group is (703) 305-3014.

Any inquiry of a general nature or relating the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.